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Danny A. Grant

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WOMBLE CARLYLE SANDRIDGE & RICE, PLLC

Immersion Corporation

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/538,163	Applicant(s) GRANT ET AL.
	Examiner HYUN NAM	Art Unit 2184

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 2,6-9,11,14-25,27,38,41 and 42 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 10, 12, 13, 26, 28-37, 39, 40, 43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>2/28/2011</u> . | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) <input type="checkbox"/> Notice of Informal Patent Application
6) <input type="checkbox"/> Other: _____. |
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DETAILED ACTION

Obvious-type Double Patenting Rejections

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-5, 10, 12, 13, 26, 28-38, 39, and 40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 7,779,166, hereinafter Grant '166. Although the conflicting claims are not identical, they are not patentably distinct from each other because for example:

Claims	Instant	Claims	Grant '162
1, 32,33	1 st handheld comm. device 2 nd handheld comm. device non-verbal chat session output signal (to 2 nd handheld) upon an actuation of user interface members on the 1 st handheld output signal includes haptic code haptic code cause haptic effect the effect on the 2 nd handheld	1, 17, 18	calling party (receiving party implied) a haptic logo (non-verbal) input signal (from sending party) control signal to an actuator (obvious to use keys) on the calling party input signal includes haptic code haptic code output haptic effect the effect on the receiving party
10	the effect identifies 1 st handheld	1 4	the effect identifies calling party (further discloses haptic output is to a handheld comm. Device)
34	antenna		(implicit on mobile phone)

The claims 1, 32, 33, and 10 of Grant '162 do not expressly disclose a 'non-verbal chat session' between calling party and receiving party and 'user interface members' of calling party.

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Kaaresoja et al. (U.S. Publication Number 2002/0177471) hereinafter Kaaresoja '471 does disclose a 'non-verbal chat session' between calling party and receiving party (text; see Paragraphs 16 and 18) and 'user interface members' (see Fig. 1, Keypad 108) on the mobile phone is a common knowledge at the time of the invention. At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate the common knowledge of caller id and key pad. The suggestion/motivation for doing so would have been to provide basic mobile phone service that everyone comes to expect.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-5, 32-34, 39, 40, and 43 are rejected under 35 U.S.C. 102(e) as anticipated by Kaaresoja '471.

Referring to claim 1, Kaaresoja '471 teaches, as claimed, a method, comprising:

generating, at a first handheld communication device (mobile phone, see Paragraph 17, Line 2) during a non-verbal chat session (text; see Paragraph 18, Lines 23-31; Note, texts sent between two phones are considered a non-verbal chat session) between the first handheld communication device and a second handheld communication device (mobile phone, see Paragraph 17, Line 2; Note, a phone implies a caller and a receiver therefore if the first handheld communication device is a caller/receiver than the second handheld communication device is a receiver/caller), an output signal (see Fig. 1, Antenna 102) upon an actuation of one or more of a plurality of user-interface members (a key of keys on keypad, see Fig. 1, Keypad 108 and Paragraph 17, Line 6) of the first handheld communication device, wherein the output signal includes a haptic code (see Fig. 1, Control Signal to Vibration Motor 100) configured to cause a haptic effect (tactile sensation; see Paragraph 11) based on the actuation; and

sending, during the non-verbal chat session, the output signal to a second handheld communication device (mobile phone, see Paragraph 17, Line 2) remote from the first handheld communication device (see Paragraph 24, Lines 9-11; Note, tactile icons composed from one device is sent to another remote device), wherein the output signal is configured to cause a haptic effect

corresponding to the haptic code (haptic effect due to vibration of a motor, see Paragraphs 9 and 11).

As to claim 3, Kaaresoja '471 teaches, the method of claim 1 wherein sending further includes in the output signal at least one of a message (voice message, see Fig. 1, Loudspeaker 114), a video image (an animation, see Paragraph 18, Line 4), or a graphical feature (pictures, see Paragraph 18, Line 3).

As to claim 4, Kaaresoja '471 teaches, the method of claim 1 wherein the haptic code is associated with a predetermined scheme (see Fig. 1, stored vibration pattern 140e; Note, predetermined vibrations patterns are stored in the memory for later determination of tactile sensation to be sent or received).

As to claim 5, Kaaresoja '471 teaches, the method of claim 1 wherein receiving further includes defining the one of the user-interface members (see Paragraph 17, Line 6; Note, a menu item is defined to the key in the keypad) include at least one of a key, a button, a key pad (see Fig. 1, Keypad 108), a direction pad, a touch screen, a scroll wheel, a mini-joystick, a trackball, and a knob (Note, the Keypad 108 is one of the user-interface member listed above).

As to claims 32, Kaaresoja '471 teaches a method to implement the same method as set forth in claim 1, wherein the at least one of the plurality of user-interface members is assigned with a haptic code configured to convey an expression or behavior (chose a tactile icon from a menu, see Paragraph 17).

As to claims 33, it is directed to a program code to implement the method as set forth in claim 32. Therefore, it is rejected on the same basis as set forth hereinabove.

As to claims 34, it is directed to a device to implement the method as set forth in claim 32. Therefore, it is rejected on the same basis as set forth hereinabove.

As to claim 39, Kaaresoja '471 teaches, the method of claim 1, wherein the haptic code (see Fig. 1, Control Signal to Vibration Motor; Note, the Instant Disclosure disclose that 'a haptic code' is extracted from the input signal and 'the extracted haptic code' may be directly applied. Examiner also notes that the output signal of the first device is the input signal of the second device. See figure 3 and paragraph 38 of Instant Application. In a same way, Kaaresoja '471, discloses that 'a control signal' is extracted from input signal of Transceiver 104 via Controller 106) is configured to be directly applied to an actuator (see Fig. 1, Vibration Motor 100) of the second handheld communication device to cause the haptic effect.

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As to claim 40, the modification teaches, the method of claim 32, further comprising:

receiving a second indication that a second one of the plurality of user interface members has been actuated, wherein the second one of the plurality of user-interface members is assigned with a second haptic code configured to convey a second expression or behavior, wherein the second haptic code is different from the first haptic code (means for selecting a tactile sensation pattern from a storage, see Kaaresoja '471, Paragraph 12, Note, mere duplication or repeating step is not an inventive concept);

generating a second output signal in response to the second indication, wherein the second output signal includes the second haptic code; and

sending the second output signal to the second handheld communication device, wherein second output signal is configured to cause a second haptic effect corresponding to the second haptic code.

As to claim 43, the Kaaresoja '471 teaches a method, comprising:

receiving, at a first handheld communication device (mobile phone, see Paragraph 17, Line 2) during a non-verbal chat session (text; see Paragraph 18, Lines 23-31; Note, texts sent between two phones are considered a non-verbal

chat session) between the first handheld communication device and a second handheld communication device (mobile phone, see Paragraph 17, Line 2; Note, a phone implies a caller and a receiver therefore if the first handheld communication device is a caller/receiver than the second handheld communication device is a receiver/caller), an actuation of one or more of a plurality of user-interface members (a key of keys on keypad, see Fig. 1, Keypad 108 and Paragraph 17, Line 6) of the first handheld communication device,

wherein an avatar (enhanced visual icons, see Paragraph 18) representing a user (see Paragraph 18; Note, when a user sends animation combined with vibration pattern and text to enrich the communication experience these communication means represent the user) is displayed during the non-verbal chat session (text, see Paragraph 18), the avatar exhibiting a particular behavior (animation) that changes (Note, by definition, an animation is a changing of still pictures) during the non-verbal chat session based on which ones of the plurality of user-interface members (chose a tactile icon from a menu, see Paragraph 17) are actuated;

generating, at the first handheld communication device, an output signal based on the actuation, wherein the output signal comprises a haptic code (see Fig. 1, Control Signal to Vibration Motor 100) configured to cause a haptic effect (tactile sensation; see Paragraph 11) that is synchronized with the particular behavior of

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the avatar (see Fig. 2, 'That's it!'; Note, when the 'That's it!' vibration is sent along with enhanced visual icons, they are synchronized); and sending the output signal to the second handheld communication device during the non-verbal chat session.

Claims 10, 12, 13, 26, and 28-31 rejected under 35 U.S.C. 102(e) as anticipated by Kaaresoja '471, further evidenced by Ronkainen (U.S. Patent 6,850,150) here in after Ronkainen '150.

As to claims 10, 12, and 13, they are directed to a non-transient computer-readable medium on which is encoded program code to implement the methods as set forth in claims 1, 3, and 4 respectively. Additionally, Kaaresoja '471 teaches a haptic code configured to distinctly identify the first handheld communication device and a status event. Examiner construed the claim limitation as a caller id or way the receiver to identify different callers via tactile sensation. Examiner, in previous office action dated 10/27/2010, also contended that such feature was already implicit in Kaaresoja '471 by proposing to upgrade the caller id feature of Ronkainen '150 (see Kaaresoja '471, Paragraph 9 and see Ronkainen '150 Column 2, Lines 25-40). The Applicant was silent to this contention in Applicant's responses dated 1/3/2011 and 2/28/2011. Therefore, Examiner will maintain the contention and it is rejected on the same basis as set forth hereinabove.

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As to claim 26, it is directed to a handheld communication device to implement the program as set forth in claim 10. Therefore, it is rejected on the same basis as set forth hereinabove.

As to claim 28, Kaaresoja '471 teaches, the handheld communication device of claim 26, wherein the handheld communication device is one of a cellular phone (see Fig. 1, a Block Diagram of a Mobile Phone), a satellite phone, a cordless phone, a personal digital assistant, a pager, a two-way radio, a portable computer, a game console controller, a personal gaming device, or an MP3 player (Note, the mobile phone is one of the device listed above).

As to claim 29, Kaaresoja '471 teaches, the handheld communication device of claim 26 wherein the plurality of user-interface members includes at least one of a key (a key on keypad, see Fig. 1, Keypad 108), a button, a key pad (see Fig. 1, Keypad 108), a direction pad, a touch screen, a scroll wheel, a mini-joystick, a trackball, or a knob (Note, the Keypad 108 is one of the user-interface member listed above).

As to claims 30, Kaaresoja '471 teaches, the handheld communication device of claim 26 further comprising memory (see Fig. 1, Memory 140), wherein the memory stores program code (see Fig. 1, Vibration pattern interpreter 140a) for extracting a haptic stimuli (see Fig. 2, Vibration patterns) from the input signal.

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As to claim 31, Kaaresoja '471 teaches, the handheld communication device of claim 26 further comprising a display device (see Fig. 1, Display 110) in communication with the processor (see Fig. 1, Controller 106), the processor to cause the display device to produce an image of the identified source (pictures, see Paragraph 18, Line 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 35-37 are rejected under 35 U.S.C. 103(a) as obvious over Kaaresoja '471 in view of Epstein et al. (U.S. Publication 2003/0038776), hereinafter Epstein '729 and Amon (U.S. Publication 2002/0107936), hereinafter Amon '936.

Referring to claims 35-37, Kaaresoja '471 teaches, as claimed, a method of claim 1, a non-transient computer readable medium of claim 10, and a device of claim 26 respectively.

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Kaaresoja '471 does not disclose expressly wherein the status event is selected from the group consisting of an advertisement event, a one-to-one marketing event, a business-transaction event, a stock-trading event, a weather-forecast event, and an emergency event.

Epstein '729 does disclose a wherein the status events consisting of an advertisement event (see Paragraph 14), a one-to-one marketing event (see Paragraph 16), a business-transaction event (see Paragraph 27), and a stock-trading event (exchange, see Title and Fig. 11).

Amon '936 does disclose a weather-forecast event (see Paragraph 16) and an emergency event (see Fig. 6).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to incorporate status events of Epstein '729 and Amon '936 into Kaaresoja '471.

The suggestion/motivation for doing so would have been to provide most comprehensive mobile PDA and/or Phone services.

Response to Arguments

Applicant's arguments filed 2/28/2011 have been fully considered but they are mostly moot in view of new grounds of rejections.

Applicant argues, Fukuhara does not recognize that chat sessions without haptic effects have limitations for sharing wet information as alleged by the Examiner. Instead, Fukuhara suggests that touch has limitations. Nonetheless, solely in an effect to expedite prosecution of this application, the claims have been amended to recite the "output signal and the signal are communicated during a non-verbal chat session between the first handheld communication device and the second handheld communication device." Fukuhara does not teach or suggest at least this feature of the claims as amended. The remaining references relied upon by the Examiner fail to cure at least this deficiency of Fukuhara. As such, the rejection of claims 32-34 as amended are improper and must be withdrawn.

Examiner disagrees with applicant. The argument Fukuhara is moot because Examiner finds that the Kaaresoja '471 teaches text sessions between the mobile phones. The Kaaresoja '471 discloses the mobile phone users are able to send text (along with corresponding vibration patterns) to each other. An exchange of texts is a non-verbal chat session.

Applicant argues, claim 43 is newly added. The references relied upon by the Examiner, either alone or in combination with one another, fail to disclose, teach, or suggest all the features of claim 43. As such, claim 43 is allowable over the references relied upon by the Examiner.

Examiner disagrees with applicant. Examiner mistakenly thought that claim 43 was allowable over prior arts of record because of the missing claim element from prior arts, an avatar. However, a dictionary defines an avatar to be an icon (see 'avatar' definition on 'www.credoreference.com/entry/hargravecomms/avatar') and the tem does not have specific definition in the disclosure of the Instant Application. Kaaresoja '471 does disclose an 'enhanced visual icon'. See the rejection given in claim 43 above.

The examiner invites applicant to call and schedule an interview prior to responding to this office action if there are issues in the above rejection which are not clear or if applicant believes it would be helpful to discuss the claim language required to overcome the rejections above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hyun Nam whose telephone number is (571) 270-1725 and fax number is (571) 270-2725. The examiner can normally be reached on Monday through Friday 8:30 AM to 5:00 PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Henry Tsai can be reached on (571) 272-4176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/HYUN NAM/

Examiner, Art Unit 2184